



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,698	06/02/2006	Takashi Kenmoku	03500.103896.	6953
5514 7590 07/22/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
BOYKIN, TERRESSA M				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
07/22/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/581,698

Applicant(s)

KENMOKU ET AL.

Examiner

Terressa M. Boykin

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Response to Arguments

Applicant's arguments filed 6-24-8 with regard to claims 1-5 have been fully considered but they are not persuasive.

Although applicants' arguments are well noted and understood. The Examiner would like to point out that applicants have focused on the aspects of how the PHA of the reference **USP 6083729** is *obtained* (whether via plant etc.) and not on the structure of the polyhydroxyalkanoate itself. This is irrelevant with regard to claims 1-5 since the no process is claimed therein.

Secondly, the applicants have stated that Martin provides no reason for one skilled in the art to even embark on such research...." However, **USP 6083729** does simply states as noted previously that the side chain may include hydrocarbon radicals, halo- and hydroxy-substituted radicals....as note in col. 3 lines 62-67 and acknowledged by applicants argument on page 16.

Applicant's arguments filed 6-24-8 with regard to claims 6-11 have been fully considered and are persuasive with regard to the reference **USP 6083729**.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

First the recited subscripts for R_1 , R_{1a} and OR_{1a} , i.e. "1a", has not been properly defined and does not exist in the structural formula.

Next, the recited "*when multiple units exist*" is also unclear" as applicants intended meaning with regard to the units and/or situation "when" this applies.

Lastly, note that when m is 0, or zero, it is not clear whether the chemical formula does in fact remain within the scope of the specifications intended polyhydroxyalkanoate as claimed.

With regard to claims 6 -11 note that although applicants have set forth the process steps including that of polymerizing and subjecting are properly set forth in the specification, it is noted that the steps contain therein with specific parameters, amounts or conditions upon which these steps may be performed as found in paragraphs [0048], [0061], [0068], [0075]. And, although applicants have set forth these parameters as being *preferable*, there is no indication or examples that parameters, conditions *or amounts* outside of those disclosed would result in the polymer as claimed and discussed. The claimed process must recite *all* positive, active step and any process parameters necessitated by the specification so that the claim will "clearly set out and circumscribe a particular area with a reasonable degree of precision and particularity, In re Moore, 169 USPQ 236, and make it clear what subject matter the

Art Unit: 1796

claim encompasses, as well as make clear the subject matter from others would be precluded. In re Hammack 166 USPQ 204.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terressa Boykin whose telephone number is (571) 272-1069 . The examiner can normally be reached at (571) 272-0580 on Monday through Friday from 9:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck , can be reached at (571) 272- 1078 . The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**/Terressa M. Boykin/
Primary Examiner, Art Unit 1796**